



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,537	12/15/1999	JOHN C. ROYER	4216.260-US	3928

25907 7590 10/01/2003
NOVOZYMES BIOTECH, INC.
1445 DREW AVE
DAVIS, CA 95616

EXAMINER

MARVICH, MARIA

ART UNIT	PAPER NUMBER
----------	--------------

1636

16

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/461,537

Applicant(s)

ROYER ET AL.

Examiner

Maria B Marvich, PhD

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1636

DETAILED ACTION

This Office Action is in response to the amendment filed 07/23/03, Paper No. 14. Claim 26 has been canceled. Claims 27-28 are pending in the application.

Claim Objections

Claim 27 is objected to because of the following informalities: host in line 3 is misspelled. Appropriate correction is required.

Sequence Compliance

The application contains sequence disclosures that are encompassed by the definition for nucleotide and/or amino acid sequences set forth in 37 C.F.R. 1.821(a)(1) and (a)(2). However, the application fails to comply with the requirements of 37 C.F.R. 1.821(a)(1) and (a)(2) for the reasons set forth in the attached Notice to Comply With Requirements for Patent Applications Containing Nucleotide Sequence Disclosures And/Or Amino Acid Sequence Disclosures. Specifically, the application does not contain as a separate part of the disclosure a disclosure of the nucleotide and/or amino acid sequences and associated information, using the format and symbols that are set forth in 37 CFR 1.822 and 1.823, see MPEP 1.821(c). It is noted that applicants in a letter filed 2/4/02, Paper No. 7, have stated that the Paper Copy of the Sequence Listing is included in the originally filed specification of the instant application. However, no Sequence Listing is associated with the instant application. Submit a paper copy of the Sequence Listing with a statement that the CRF and the paper copy of the Sequence Listing are the same.

Art Unit: 1636

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This rejection is maintained for reasons of record in the office action filed 4/24/02 and restated below.**

Since the specific *Fusarium venenatum* cells deposited at ATCC 20334 are essential to the claimed invention, they must be obtainable by a repeatable method set forth in the specification or otherwise readily available to the public. The invention does not recite use of any cells but instead specifically claims *Fusarium venenatum* cells deposited at ATCC with deposit #20334. The *Fusarium venenatum* cells deposited at ATCC under #20334 are commercially available, however, commercial availability is not necessarily evidence that the public will have access to the material for the life of a patent (see MPEP 2404.01) (emphasis added). The *Fusarium venenatum* of the invention were apparently deposited by others, their availability in an unrestricted form for the life of a patent issued on the instant application cannot be ensured. Applicants must therefore deposit the specific *Fusarium venenatum* recited in the claims and thus satisfy the deposit requirement under 37 CFR 1.801-1.809.

Art Unit: 1636

Response to Arguments

Applicants traverse the claim rejections under 35 U.S.C. 112, first paragraph, on pages 3-4 of the amendment filed 7/23/03, Paper No. 14. Applicant argues that the *Fusarium venenatum* cells deposited at ATCC with deposit #20334 are known and readily available to the public as evidenced by the ATCC catalog which lists *Fusarium venenatum* cells ATCC 20334 and by the letter from Elizabeth Kerrigan of ATCC confirming that *Fusarium venenatum* cells deposited at ATCC 20334 are preserved in the open collection and are currently available to the public.

Applicant's arguments filed 7/23/03 have been fully considered but they are not persuasive. MPEP 2404.01 states that the biological material must be "known and readily available"- neither concept alone is sufficient. The cells at ATCC deposited as ATCC 20334 are known as commercially available cell lines. However, as the applicant has not apparently deposited the cells, commercial availability cannot be guaranteed for the life of the patent should the cells be withdrawn from the open collection by the original depositors. Public access during the term of the patent may affect the enforceability of the patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B Marvich, PhD whose telephone number is (703) 605-1207. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, PhD can be reached on (703) 305-1998. The fax phone numbers for

Art Unit: 1636

the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3291.

Maria B Marvich, PhD
Examiner
Art Unit 1636

September 28, 2003


TERRY MCKELVEY
PRIMARY EXAMINER

Notice to Comply	Application No.	Applicant(s)	
	09/461,537	Royer et al.	
	Examiner	Art Unit	
	M. Marvich	1636	

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other .

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY